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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) NAN138 US | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 3, 2009</u> Signature <u>Michael J. Halbert</u> Typed or printed name <u>Michael J. Halbert</u> | | Application Number 10/572,329 | Filed December 12, 2006 |
| First Named Inventor Michael John Hammond | | Art Unit 2872 | |
| Examiner Thong Q. Nguyen | | Application Number 10/572,329 | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> | | | |
| I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,633</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | <div style="text-align: center;"> Signature Michael J. Halbert Typed or printed name (408) 378-7777 x 112 Telephone number <u>3-3-09</u> Date </div> | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | |

☒ *Total of 3 forms are submitted.

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ARGUMENTS FOR REQUESTING PRE-APPEAL BRIEF REVIEW

Claims 1-8, 10, 12-14, and 16-17 currently stand rejected as unpatentable over Mueller (4,025,785) ("Mueller"). Claim 9 has been indicated as being allowable if placed in independent form. Applicant submits that the rejection based on Mueller lacks a factual basis and does not include at least one limitation in the claims.

Claim Rejections – 35 U.S.C. §102

Claims 1-8, 10, 12-14, and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by Mueller.

Independent Claims 1 and 12

Independent claim 1 recites the "reflected light is projected to the imaging system in which the reflected light is split into at least two images from eccentric sections of an imaging pupil differentially displaced from the optical axis". Independent claim 12 recites "the imaging system comprising optics to split the reflected light into at least two images from eccentric sections of an imaging pupil differentially displaced from the optical axis".

The Examiner's rejection of claims 1 and 12 is premised on Mueller disclosing that "the objective lens (1) acts as an optics for splitting light reflected from a spot (17a) of an object (4) to an imaging system having a first imaging system (32, 33) and a second observation system (7-10, 13-14)." See, page 7 of the final Office Action, dated December 4, 2008. Applicant respectfully disagrees and submits that the Examiner rejection (1) lacks a factual basis, and (2) fails to present a *prima facie* case.

Lack of Factual Basis

The objective lens (1) of Mueller, in fact, does not "split" the light reflected from the spot (17a) of an object (4). As is well known, an objective lens focuses light and produces a real image of the object being observed. The objective lens (1) of Mueller is used along with additional objective lenses 2 and 3 to present images of the object 4 at the intermediate image planes 5 and 6. Col. 2, lines 58-68 and Fig. 1. The objective lenses 2 and 3 are offset from the center of the objective lens 1 and thus, produce images of the object 4 at slightly different perspectives, which explains why Mueller refers to his system as a "stereoscopic microscope". See, Title, and col. 2, lines 58-68. The objective lens 1 and objective lenses 2

and 3, however, do not “split” the reflected light ... into at least two images” as recited in claims 1 and 12, but instead form two images of the object 4 from different perspectives. There is no factual basis for the Examiner’s position that the objective lens (1) acts as an optic for splitting light.

Applicant points out that to maintain the Examiner’s position that Mueller’s disclosure of producing two images of an object from different perspectives using objective lens 1 (and objective lenses 2 and 3) is the same as the claimed feature that “the reflected light is split into at least two images” requires ignoring the explicitly recited term “split”. An object lens does not “split” light. Thus, to maintain the Examiner’s position requires that the term “split” be ignored, which is improper.

No Prima Facie Case

Applicant’s independent claims 1 and 12 both require that the reflected light is split into the two images within the imaging system. For example, independent claim 1 recites the “reflected light is projected to the imaging system in which the reflected light is split into at least two images ...” and independent claim 12 recites “the imaging system comprising optics to split the reflected light into at least two images....”

As discussed above, the Examiner’s rejection is based on “the objective lens (1) acts as an optics for splitting light reflected from a spot (17a) of an object (4) to an imaging system” Even if one were to accept the Examiner’s position that the objective lens (1) splits the reflected light and provides that light an imaging system¹, Mueller still does not anticipate independent claims 1 or 12 as Mueller does not disclose splitting the reflected within the imaging system.

Applicant points out that the Examiner does not interpret Mueller as disclosing that the object lens (1) is part of the imaging system. The Examiner states “the objective lens (1) acts as an optics for splitting light reflected from a spot (17a) of an object (4) to an imaging system”, clearly indicating that the objective lens (1) and the imaging system are separate elements. Moreover, an interpretation that the “objective lens” is part of the “imaging system” would be improper because both independent claims 1 and 12 recite an “objective lens” and “an imaging system” separately, thereby indicating that these elements are distinct.

¹ As discussed, above, this position is factually incorrect.

If the “objective lens (1)” of Mueller is considered part of the “imaging system,” then Mueller fails to disclose an objective lens that is separate from the imaging system as required by claims 1 and 12.

Applicant notes that in the Response to Argument section of the final Office Action, dated December 4, 2008, the Examiner raised several digressive issues, such as Applicant’s arguments failing to comply with 37 CFR 1.111(c) and claims 1-8, 10, 12-14 and 16 lacking “specific limitation(s) related to the component(s) used to split the reflected light”. Applicant responded to these issues at pages 7 and 9 of the Response to Office Action dated January 28, 2009, which is incorporated herein by reference. Applicant further submits that regardless of these issues, the Examiner’s rejection still lacks a factual basis and fails to present a *prima facie* case as discussed above.

Thus, Applicant respectfully submits that independent claims 1 and 12 are patentable over Mueller. Reconsideration and reversal of this rejection is respectfully requested. Claims 2-10 and 16 depend from claim 1 and claims 13-14 and 17 depend from claim 12, and are, therefore, likewise patentable for at least the same reasons.

Dependent Claims

Claims 2-10 and 16 depend from claim 1 and claims 13-14 and 17 depend from claim 12, and are, therefore, likewise patentable for at least the same reasons.

Moreover, claims 3 and 4 relate to imaging the two eccentric sections on a “single imaging means”. Mueller, on the other hand, discloses the use of two separate photoelectric detectors 32 and 33. Col. 32-40. Thus, a *prima facie* case has not been made with respect to claims 3 and 4.

Additionally, claim 14 recites that “the optics to split the reflected light into at least two images from eccentric sections of the imaging pupil comprises a dihedral mirror.” Mueller, on the other hand, does not disclose splitting the reflected beam into the two images from eccentric sections of the imaging pupil, much less, using a dihedral mirror to do so. Applicant points out that the Examiner stated that claim 9 was allowable with substantially the same elements. In the Response to Arguments, the Examiner stated with respect to claim 14, that Mueller clearly includes “a pair of the beamsplitter or dihedral mirror”. Applicant

notes that this is contrary to the Examiner's statement with respect to claim 9 and is factually incorrect, i.e., Mueller does not disclose a dihedral mirror. Thus, a *prima facie* case has not been made with respect to claim 14 and claim 14 should be allowable for at least the same reasons that claim 9 has been indicated as being allowable.

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